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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,158	08/27/1999	MICHAEL S. BORELLA	99.226	7444
20306	7590	10/06/2004	EXAMINER	
MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP			NOBAHAR, ABDULHAKIM	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			2132	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/384,158	Applicant(s) BORELLA ET AL.	
	Examiner Abdulhakim Nobahar	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicants' response received on July 20, 2004.
2. The terminal disclaimer filed on July 20, 2004 by the applicants, is accepted and the examiner withdraws the double patenting rejections.
3. Applicants' argument, see remarks, filed July 20, 2004, with respect to the rejection of claims 1-20 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Minear et al (5,983,350) (hereinafter Minear).

Referring to claims 1-3, Minear discloses a method and system for a secure network by regulating the flow of messages through a firewall and authenticating the sender of a message (col. 2, lines 50-67). Minear further discloses:

“providing a first network device and a second network device on a first network”. See Figs. 1, 3 and 5, where the workstation H1 and the gateway firewall SW1 correspond to the recited first and second devices on the first network.

“establishing a security association between the first network device and a third network device on a second network external to the first network”. See col. 4, lines 8-28.

“Specifying an external address of the third network device for the security association”. See col. 4, lines 8-28, where the destination address corresponds to the external address...

“Storing the external address in a table on the second network”. See col. 7, lines 23-40.

“Mapping at least one of an internal address and a security value to the external address in the table”. See col. 4, lines 1-15; col. 5, lines 29-36, where selecting the SPI value based on the destination address and the sender ID corresponds to the recited mapping... and the security association is kept in a table in the firewall (col. 7, lines 23-40).

Referring to claim 4, Minear discloses:

"the security value is a security parameter index for an internet Protocol security protocol. See col. 4, lines 8-12.

Referring to claim 5, Minear discloses:

"the Internet Protocol security protocol is any of an Authentication Header protocol, Encapsulated Security Payload protocol, or an Internet Key Exchange protocol. See col. 2, lines 1-5.

Referring to claim 6, Minear discloses:

"specifying the external address of the third network device for the security association with a Port Allocation Protocol external address validating message sent from the first network device to the second network device". See col. 4, lines 8-15 and col. 5, lines 34-45.

Referring to claim 7, Minear discloses:

" the Port Allocation Protocol external address validating message has a valid external address field". See col. 2, lines 27-44; col. 4, lines 24-27; col. 9, lines 27-40 and lines 52-62.

Referring to claim 8, Minear discloses:

“removing the external address from the table with a Port Allocation Protocol external address invalidating message sent from the first network device to the second network device”. See col. 5, lines 26-33; col. 9, lines 58-62 and Fig. 3.

Referring to claim 9, Minear discloses:

“the Port Allocation Protocol external address invalidating message has an invalid external address field”. See col. 4, lines 24-27; col. 5, lines 26-33.

Referring to claims 10-12, Minear discloses:

“providing a first network device and a second network device on a first network, and a third network device on a second network external to the first network”. See Figs. 1, 3 and 5, where the workstation H1 and the gateway firewall SW1 correspond to the recited first and second devices on the first network and H2 corresponds to the recited third device on the network.

“Sending a packet having an external address from the third network device to the first network device”. See Fig. 3, where the H2 device has an address.

“intercepting the packet with the second network device”. See Fig. 3, where the packets are processed (corresponding to the recited intercepting) by the gateway firewall SW1 coming from the external network 19.

“determining whether the security value of the packet has been allocated to the first network device”. See col. 4, lines 29-42, where identifying a security association based

on the destination address (destination address here corresponds to the address of the recited first network device) corresponds to determining...; col. 4, line 59-col. 5, line 8 and col. 5, line 65-col. 6, line 13.

"determining whether the external address of the packet has been specified by the first network device as being valid". See col. 5, lines 25-33; col. 5, line 65-col. 6, line 13.

"sending the packet from the second network device to the first network device if the security value has been allocated to the first network device and the external address of the packet has been specified by the first network device as valid". See col. 5, lines 9-33.

Referring to claim 13, Minear discloses:

"the security value is a security parameter index for an Internet Protocol security protocol. See col. 4, lines 8-12.

Referring to claim 14, Minear discloses:

"the Internet Protocol security protocol is either an Authentication Header protocol or an Encapsulated Security Payload protocol. See col. 2, lines 1-5.

Referring to claim 15, Minear discloses:

"discarding the packet if the security value of the packet has not been allocated to the first network device". See col. 5, lines 9-33.

Referring to claim 16, Minear discloses:

“discarding the packet if the external address of the packet has not been specified by the first network device as being valid”. See col. 5, lines 9-33.

Referring to claim 17, Minear discloses:

“discarding the packet if the security value of the packet has not been allocated to the first network device, and discarding the packet if the external address of the packet has not been specified by the first network device as being valid. See col. 5, lines 9-33.

Referring to claim 18, Minear discloses:

“ specifying the external address as being valid if a security association has been established between the first network device and the third network device”. See col. 4, line 59-col. 5, line 8.

Referring to claim 19, Minear discloses:

“storing a valid external address in a table on the second network device. See col. 7, lines 23-39.

Referring to claim 20, Minear discloses:

“a routing network device using distributed network address translation with security to provide routing services for a plurality of internal and external network devices” (See

Fig. 3, where SW2 corresponds to the recited routing network device and col. Col. 4, line 8-28); and

“an established security association table associated with the routing network device for storing external addresses of external network devices that have established security associations with internal network devices” (See Fig. 4, where the security association database 54 corresponds to the recited table and col. 7, lines 23-50), and “mapping external addresses that have been specified as valid by the internal network devices to one of internal network addresses and security values for established security associations” (See col. 4, lines 1-15; col. 5, lines 29-36; col. 7, lines 23-40, where selecting the SPI value based on the destination address and the sender ID corresponds to the recited mapping... and the security association is kept in a table in the firewall).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,828,846 to Kirby et al.

US Patent No. 5,793,763 to Mayes et al.

US Patent No. 6,233,234 B1 to Curry et al.

US Patent No. 5,960,177 to Tanno.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abdulhakim Nobahar
Examiner
Art Unit 2132

AN

September 30, 2004


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